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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/814,557

03/31/2004

Diane Bihary

7432

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MAGINOT, MOORE & BECK, LLP

CHASE TOWER

111 MONUMENT CIRCLE

SUITE 3250

INDIANAPOLIS, IN 46204

EXAMINER

REIMERS, ANNETTE R

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

06/15/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/814,557	Applicant(s) BIHARY ET AL.	
	Examiner Annette R. Reimers	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 12-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 20-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/31/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election of invention I, claims 1-11 and 20-30, and species/sub-species of figure 11 in the reply filed on May 15, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Examiner further acknowledges that applicant believes that claims 1-11 and 20-30 read on the elected species/sub-species of figure 11. Examiner agrees with applicant that claims 1-11 and 20-30 read on the elected species/sub-species of figure 11.

Claims 12-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 15, 2007.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 8, 11, 25-27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Wendt (US Patent Number 5,896,886).

Wendt disclose a handheld instrument for insertion of an acetabular liner into an acetabular cup comprising: a shaft, e.g. 25, having an internal channel, e.g. 11, therethrough and a first and a second end portion, a bulb syringe, e.g. 35, sealingly engaged with the first end portion of the shaft and a head (see figure 2) having a curvilinear outer perimeter and an internal chamber (see figure 2), a first o-ring/first groove, e.g. 21 (see figure 3 and column 3, lines 2-8) circumscribing the curvilinear outer perimeter of the head and a valve/stop check valve, e.g. 26 (see figures 1-3).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Wendt, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Moreover, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendt (US Patent Number 5,896,886) in view of Baumann (US Patent Number 3,723,995).

Wendt discloses the claimed invention except a second o-ring/groove/channel. Baumann discloses two o-rings/grooves/channels, e.g. 5 and 6, in an acetabular head, e.g. 1, and liner, e.g. 2, combination for proper sealing engagement (see figure and column 1, lines 52-55). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Wendt with a second o-ring/groove/channel, in view of Baumann, for proper sealing engagement.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendt (US Patent Number 5,896,886) in view of Skow (US Patent Number 6,620,132).

Wendt discloses the claimed invention except for an additional valve. Skow discloses a bulb syringe 2 valve system and teaches the second valve "to prevent liquid from exiting the valve until a predetermined amount of pressure is provided by bulb actuation" (see figure 19 and claim 1). ). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Wendt with a second

o-ring/groove/channel, in view of Skow, to prevent liquid from exiting the valve until a predetermined amount of pressure is provided by bulb actuation.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendt (US Patent Number 5,896,886).

Wendt discloses the claimed invention except the shaft having a bend of between about 20 and about 45 degrees and about 30 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Wendt with the shaft having a bend of between about 20 and about 45 degrees and about 30 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendt (US Patent Number 5,896,886) in view of Sweeney (US Patent Publication Number 2005/0015059).

Wendt discloses the claimed invention except a kit having a plurality of heads. Sweeney discloses a kit having a plurality of inserts to allow the surgeon "to select an appropriate insert based on the particular needs of the patient" (see paragraph 0039). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Wendt as a kit having a plurality of heads, in view of Sweeney, to allow the surgeon to select an appropriate insert based on the particular needs of the patient.

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Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wendt (US Patent Number 5,896,886) in view of Sweeney (US Patent Publication Number 2005/0015059).

Wendt discloses the claimed invention except heads fit with liners having diameters of 26mm, 28mm, 32mm, 36mm or 38mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Wendt with heads fit with liners having diameters of 26mm, 28mm, 32mm, 36mm or 38mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for art cited of interest.

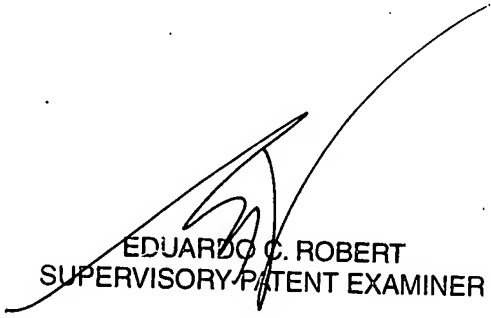
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER